

### **REMARKS**

This is in response to the Office Action mailed on August 26, 2004, in which claims 1, 12 and 17 were rejected under 35 U.S.C. §102(b) and claims 2-11, 13-16 and 18-23 were rejected under 35 U.S.C. §103(a).

#### **Amendments to the Specification**

The amendments to the specification were made for clarity and were not intended to introduce any new matter.

#### **Amendments to the Drawings**

Enclosed is an Amendment to the Drawings under 37 C.F.R. § 1.121(d) with the submission of two (2) sheets of corrected formal drawings for filing in the above-identified application.

Page 2/3, featuring FIG. 5, is submitted with the following changes: Reference numerals 16, 24, 32, and 38, which are referenced in portions of the specification describing FIG. 5, have been added.

Page 3/3, featuring FIG. 6, is submitted with the following changes: 1) Reference numerals 20, 28, and 40, which are referenced in portions of the specification describing FIG. 6, have been added and 2) the positioning of template 10 with respect to wall surface 64 has been adjusted to more clearly show that transverse edge 20 of template 10 is positioned flush against wall surface 64, as described in the specification at page 9, lines 9 through 12.

Acceptance of these drawing amendments is respectfully requested.

#### **Amendments to the Claims**

With this Amendment, claims 1, 7, 11, 12, 17 and 19-23 have been amended. Claim 1 was amended to correct an informality and an antecedent error. Claim 7 was amended to correct an informality. Claims 11 and 12 were each amended to correct an informality and an antecedent

error. Claim 17 was amended to delete a superfluous feature of the graduated marking zone and correct a spelling error. Claims 19-21 and 23 were amended to depend from claim 17, while claim 22 was amended to depend from claim 19. None of the above claim amendments were made for patentability purposes or in response to an Examiner rejection or objection, but rather the amendments were made for purposes of clarifying the invention.

Claim Rejections-35 U.S.C. §102(b)

Claims 1, 12 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,443,949 ("Newton").

Independent claim 1 recites a template for laying out electrical conduit positions on an electrical panel housing. The template includes a sheet having a longitudinal straight edge for engaging a wall surface on which the electrical panel housing is fixed. A spacer zone is bordered on one side by the longitudinal straight edge and extends the length of the template. The spacer zone has a width in the transverse direction that corresponds to the thickness of a support means used to secure the electrical conduit to the wall surface. A marking zone extends parallel to the longitudinal straight edge and is spaced from the longitudinal straight edge by the spacer zone. The marking zone has a width in the transverse direction corresponding to an outside diameter of a given size of electrical conduit. A plurality of apertures are formed through the sheet and are centered on the marking zone. The plurality of apertures form a line parallel to the longitudinal straight edge and are designed to receive a tool for marking the center locations of entry holes.

Claim 1 was rejected under 35 U.S.C §102(b) as being anticipated by Newton, which discloses a template having a centerline and a pair of mirror image hole arrays located on each side of the centerline for symmetrically locating a pair of fasteners on a wall hanging such as a picture frame. Newton does not teach, suggest, or disclose a spacer zone having a width in the transverse direction corresponding to a thickness of a support means used to secure electrical conduit to a wall surface. Newton reference numeral 34, referenced by the Examiner as "longitudinal spacer zone 34", does not constitute such a spacer zone. Rather, as shown in FIGs. 1 and 2 and as described in the

associated discussion at Col. 3, lines 59 through 68, reference numeral 34 denotes alphanumeric code letters (34) associated with holes arrays (32) to allow a user of the Newton template to identify holes (40) located in mirror image positions relative to the centerline. There is no disclosure, teaching or suggestion by Newton that the portion of the template upon which the alphanumeric code letters (34) are located serves any function other than acting as a substrate for displaying the alphanumeric code letters (34). Further, that this template portion does not include holes (40) does not indicate that it is intended to provide a spacing function. If holes (40) were located in this template portion, alphanumeric code letters (34) would not be readily visible, which would defeat the purpose of alphanumeric code letters (34). In addition, Newton does not disclose, teach, or suggest that this template portion has a width in the transverse direction that corresponds to the thickness of a support means used to secure the electrical conduit to the wall surface.

The Examiner also asserts that Newton discloses a marking zone (see Examiner reference letter "D") as recited in claim 1. However, there is no teaching, disclosure, or suggestion in Newton regarding a marking zone having a width in the transverse direction corresponding to an outside diameter of a given size of an electrical conduit. In fact, Newton neither discloses a particular width for the portion of the template referenced by the Examiner as marking zone D nor does it disclose any information relating to electrical conduits. Therefore, Newton does not disclose, teach, or suggest each and every feature of the invention recited in claim 1. The rejection of claim 1 under 35 U.S.C §102(b) should accordingly be withdrawn.

Independent claim 12 also recites a template for laying out the locations of electrical conduit entry holes on an electrical panel housing. The template includes a sheet, spacer zone, a marking zone, and a plurality of apertures, along with other features. The spacer zone borders a transverse edge of the sheet and has a width in the longitudinal direction equal to the thickness of a support means used to secure the electrical conduit to the wall surface. The plurality of apertures are variably spaced from the spacer zone by distances equal to the radiuses of a multitude of conduit sizes.

Newton does not disclose, teach, or suggest a spacer zone as recited in claim 12. Newton reference numeral 36, referenced by the Examiner as "transverse spacer zone 36", does not constitute such a spacer zone. Similar to alphanumeric code letters (34) discussed above with respect to claim 1, reference numeral 36 denotes alphanumeric code numerals (36), which are associated with hole arrays (32) to allow a user of the Newton template to identify holes (40) located in mirror image positions relative to the centerline. There is no disclosure, teaching or suggestion by Newton that the portion of the template upon which the alphanumeric code numerals (36) are located serves any function other than acting as a substrate for displaying the alphanumeric code letters (34). Likewise, as discussed above in the context of alphanumeric code letters (34), the fact that the template portion underlying alphanumeric code numerals (36) does not include holes (40) does not indicate that the template portion was intended to provide a spacing function. Furthermore, Newton does not disclose, teach, or suggest that this template portion has a width in the longitudinal direction that corresponds to the thickness of a support means used to secure the electrical conduit to the wall surface.

In addition, even if the above Newton feature cited by the Examiner were a spacer zone as recited in claim 12, there is no teaching, disclosure, or suggestion by Newton of locating holes (40) relative to the feature by distances equal to the radiuses of a multitude of conduit sizes. In fact, Newton does not even disclose a particular distance for locating the holes (40) relative to the template portion on which alphanumeric code numerals (36) are located. Moreover, Newton does not even provide any disclosure pertaining to electrical conduit or electrical conduit sizes. Therefore, Newton does not disclose, teach, or suggest each and every feature of the invention recited in claim 12. The rejection of claim 12 under 35 U.S.C §102(b) should accordingly be withdrawn.

Claim 17 recites a template including a longitudinal spacer zone, a transverse spacer zone, a uniform marking zone, a graduated marking zone, along with other features. As with claim 1, the width of the longitudinal spacer zone in the transverse direction corresponds to the thickness of a support means used to secure electrical conduit to a wall surface. Likewise, as with claim 12, the width of the transverse spacer zone in the longitudinal direction corresponds to the thickness of

the support means used to secure electrical conduit to a wall surface. As was discussed above with respect to claims 12 and 17, Newton does not teach, suggest, or disclose either of these spacer zones.

Claim 17 also includes a uniform marking zone with a plurality of apertures and a width in the transverse direction that corresponds to the outside diameter of a given size of electrical conduit. As discussed above for claim 1, there is no teaching, disclosure, or suggestion in Newton regarding a marking zone having a width in the transverse direction corresponding to an outside diameter of a given size of an electrical conduit. As such, Newton does not disclose, teach, or suggest multiple features of the invention recited in claim 17. The rejection of claim 17 under 35 U.S.C §102(b) should accordingly be withdrawn.

Thus, for the foregoing reasons, claims 1, 12, and 17 are not anticipated by Newton, and it is respectfully requested that the Examiner reconsider and withdraw the rejections of these claims made under 35 U.S.C. §102(b).

#### Claim Rejections-35 U.S.C. §103

Claims 2-11, 13-16, and 18-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Newton (U.S. Patent No. 4,443,949) in view of Pressey (U.S. Patent No. 4,584,780). The Examiner asserts that Newton discloses all of the features of these claims except for the specified claimed dimensions of the template and the template being made of metal. The Examiner cites Pressey to supply these deficiencies in Newton.

Claims 2-6 depend from claim 1 which, as previously discussed, recites a template including a spacer zone, a marking zone, and a plurality of apertures, along with other features. The spacer zone is bordered on one side by a longitudinal straight edge, extends the length of the template, and has a width in the transverse direction that corresponds to a thickness of a support means used to secure the electrical conduit to a wall surface. Since any claim depending from a patentable claims is also patentable, claims 2-6 are patentable if independent claim 1 is patentable. See M.P.E.P. 2143.03, citing In Re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

To reject a claim under 35 U.S.C. §103(a) as being obvious, all of the claim limitation must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1964). As discussed in regards to the 35 U.S.C §102(b) rejection of claim 1, there is no teaching, disclosure, or suggestion in Newton of a spacer zone or a spacer zone having a width in the transverse direction corresponding to the thickness of a support means used to secure the electrical conduit to a wall surface. Likewise, there is also no teaching, disclosure, or suggestion in Pressey of a spacer zone as recited in claim 1. In fact, Pressey teaches against including such a spacer zone. Pressey teaches that, to layout electrical conduit entry holes on an electrical panel so that the outer diameter of each electrical conduit is spaced a distance from a top edge (66) of the panel, straight edge (12) of the Pressey template should be placed on top of the panel along a datum line (68) drawn parallel to the top edge (66) and separated from the top edge (66) by the specified distance. See Fig. 1 and Col. 3, lines 28-39. If the Pressey template included a spacer zone as recited in claim 1, the Pressey template would no longer function as specified in Pressey because the outer edge of the conduit entry holes would no longer touch the datum line (68). Thus, the combination of Newton and Pressey does not teach, disclose, or suggest a space zone as recited in claim 1.

However, even if Newton were to disclose a spacer zone as the Examiner contends, the combination of Newton and Pressey does not teach, suggest, or disclose a spacer zone having a width in the transverse direction that corresponds to the thickness of the support means used to secure the electrical conduit to a wall surface. The Examiner asserts that Pressey supplies the specified claimed dimensions, which by inference, Applicant assumes Examiner cites Pressey to supply the spacer zone width in the transverse direction. However, there is no teaching, suggestion, or disclosure by Pressey of a width of any portion of a template that corresponds to the thickness of a conduit support means. In fact, Pressey does not even mention a support means used to secure electrical conduit to a wall surface.

Furthermore, the combination of Newton and Pressey also does not disclose, teach, or suggest a marking zone, as recited in claim 1, that is spaced from a longitudinal straight edge by

the spacer zone and has a width in the transverse direction corresponding to an outside diameter of a given size of an electrical conduit. Examiner cites Newton for disclosing a marking zone and Pressey for providing the specified claimed dimensions. While Pressey discloses both various diameters of electrical conduit (see Col. 3, lines 9-16) and spacing marking holes from a straight edge by an amount corresponding to the radius of a particular conduit size (see Col. 3, lines 6-9), Pressey does not disclose a structural feature of a template that has a width corresponding to the outside diameter of a given size of electrical conduit.

Therefore, since claims 2-6 depend from claim 1, and the combination of Newton and Pressey does not disclose, teach, or suggest multiple features recited in claim 1, it is respectfully submitted that the rejection of claims 2-6 under 35 U.S.C. §103(a) should accordingly be withdrawn. In addition, it is respectfully submitted that the combination of features recited in claims 2-5 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In Re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Independent claim 7 recites a template that includes a 3/4 inch spacer zone having a width in transverse direction of approximately three-fourths of an inch, a 1½ inch spacer zone having a width in the transverse direction of approximately one and one-half inches, and a longitudinal marking zone sandwiched between the two spacer zones and having a width in the transverse direction corresponding to the outside diameter of a given size of electrical conduit, along with other features. To reject a claim under 35 U.S.C. §103(a) as being obvious, all of the claim limitation must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1964). As previously discussed, neither Newton or Pressey discloses a spacer zone, a space zone having a width in the transverse direction corresponding to a specified dimension, or a marking zone have a width in the transverse direction corresponding to the outside diameter of a given size of electrical conduit. Thus, the rejection of claim 7 under 35 U.S.C. §103(a) should accordingly be withdrawn. Likewise, since claims 8-10 depend from claim 7, the rejections of these claims under 35 U.S.C. §103(a) should also be withdrawn.

Claim 11 recites a method for laying out the locations of electrical conduit entry holes on an electrical panel housing. A template is provided identical to the template recited in claim 7. The template is applied to the electrical panel housing so that the spacer zone, having the width corresponding to the thickness of a support means to be used to secure the electrical conduit to the wall surface, engages the wall surface. A marking tool is positioned inside the desired apertures and the locations of the entry holes to be made on the electrical panel housing are marked. As discussed above in regards to claim 7, the combination of Newton and Pressey does not disclose, suggest or teach a template having two spacer zones each bordered by a different longitudinal straight edge, nor does the combination disclose, teach, or suggest a longitudinal marking zone having a width in the transverse direction corresponding to the outside diameter of a given size of an electrical conduit. Further, there is no teaching, suggestion, or disclosure in either Newton or Pressey of applying the template to the electrical panel housing so that the spacer zone with a width corresponding to the thickness of a conduit support means engages the wall surface. Thus, the combination of Newton and Pressey does not teach, disclose, or suggest each and every feature recited in claim 11. The rejection of claim 11 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Claims 13-16 depend from independent claim 12. As discussed above in regards to the 35 U.S.C. §102(b) rejection of claim 12, Newton does not teach, suggest, or disclose (1) a spacer zone, (2) a spacer zone having a width in the longitudinal direction equal to the thickness of an electrical conduit support means, nor (3) a plurality of apertures variably spaced from the spacer zone by distances equal to the radiuses of a multitude of conduit sizes. Likewise, there is no teaching, suggestion, or disclosure in Pressey of these features as recited in claim 12. Since claims 13-16 depend from claim 12, which is in condition for allowance, it is respectfully submitted that the rejections of these claims under 35 U.S.C. § 103(a) should accordingly be withdrawn. See M.P.E.P. 2143.03, citing In Re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claims 18-23 depend from claim 17. As discussed above in regards to the 35 U.S.C. §102(b) rejection of claim 17, Newton does not disclose, teach, or suggest multiple features of claim 17. In particular, Newton does not disclose (1) a longitudinal spacer zone having a width



corresponding to the thickness of an electrical conduit support means, (2) a transverse spacer zone having a width in the longitudinal direction corresponding to a thickness of an electrical conduit support means, or (3) a uniform marking zone having a width in the transverse direction corresponding to the outside diameter of given size of electrical conduit. Likewise, there is no teaching, suggestion, or disclosure in Pressey of these features as recited in claim 17. As such, since claims 18-23 depend from claim 17, it is respectfully submitted that the rejections of claims 18-23 under 35 U.S.C. § 103(a) should accordingly be withdrawn. See M.P.E.P. 2143.03, citing In Re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

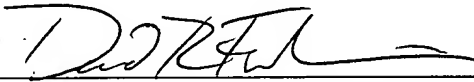
**CONCLUSION**

In view of the foregoing, all pending claims 1-23 are in condition for allowance. Reconsideration and notice to that effect is respectfully requested. The Examiner is authorized to charge any additional fees associated with this application or credit any overpayment to Deposit Account No. 11-0982. Any inquiries regarding this application should be directed to David R. Fairbairn at 612-337-9357.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 10/12/04

By:   
David R. Fairbairn, Reg. No. 26,047  
THE KINNEY & LANGE BUILDING  
312 South Third Street  
Minneapolis, MN 55415-1002  
Telephone: (612) 339-1863  
Fax: (612) 339-6580

DRF:AAD:sas



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named

Inventor : Mark S. Grendahl

Appln. No. : 10/671,426

Filed : September 25, 2003

Title : ELECTRICAL CONDUIT LAYOUT  
TEMPLATE

Docket No. : G353.12-0006

Group Art Unit: 2859

Examiner:  
Fulton, Christopher W

**AMENDMENT TO DRAWINGS UNDER 37 C.F.R. §1.121(d)**

Mail Stop Amendment  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SENT VIA EXPRESS MAIL**

Express Mail No.: EV 301105297 US

Sir:

Enclosed are two (2) sheets of formal drawings for filing in the above-identified application.

Amendments to the Drawings

Enclosed is an Amendment to the Drawings under 37 C.F.R. § 1.121(d) with the submission of two (2) sheets of corrected formal drawings for filing in the above-identified application.

Page 2/3, featuring FIG. 5, is submitted with the following changes: Reference numerals 16, 24, 32, and 38 have been added.

Page 3/3, featuring FIG. 6, is submitted with the following changes: 1) Reference numerals 20, 28, and 40 have been added and 2) the positioning of template 10 with respect to wall surface 64 has been adjusted to more clearly show that transverse edge 20 of template 10 is positioned flush against wall surface 64.

Acceptance of these drawing amendments is respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date:

10/12/04

By:

David R. Fairbairn, Reg. No. 26,047  
THE KINNEY & LANGE BUILDING  
312 South Third Street  
Minneapolis, MN 55415-1002  
Telephone: (612) 339-1863  
Fax: (612) 339-6580

DRF:AAD:sas